

REMARKS

The Office Action mailed October 21, 2008, has been received and reviewed. Claims 1 and 3-14 are currently pending in the application. Claims 1 and 3-14 stand rejected. Applicant has amended no claims, and respectfully requests reconsideration of the application as presented herein.

35 U.S.C. § 102 Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 5,713,074 to Hulbert

Claims 1, 3-6, 8-9, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,713,074 to Hulbert ("Hulbert"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that Hulbert does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 1 and claims 3-6, 8, 9 and 11 depending therefrom, and independent claim 14, because Hulbert does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

Applicant's invention as claimed generally recites:

(1) repeating a step until a sum determined at the mobile station of energy reaches a certain level.

Regarding a sum determined at the mobile station of energy, Applicant's invention as presently claimed in independent claims 1 and 14, recite in part, "**repeating** [retransmitting] **until** a sum determined at the mobile station of the first and further symbol energy amounts ... is great enough to" Hulbert discloses no such thing.

In the Response to Arguments, the Examiner states:

The *applicant argues* with respect to claim 1 on page 9, fourth paragraph that *Hulbert does not disclose: “repeating [retransmitting] until a sum determined at the mobile station* of the first and further symbol energy amounts ... is great enough to ...”, in as complete detail as claimed in amended independent claim 1. *The examiner disagrees. Hulbert clearly teaches* the receiving station (mobile station means) is communicating the correction signal to the transmitting station (base station means) by *comparing the measured power against the reflect[ed] data from receiving station (a sum determined at the mobile station* of the first and further symbol energy amount used to transmit the traffic information is great enough to permit correct demodulation by the mobile station means) (figure 2, col. 3, line 56 to col. 4, line 8). (Office Action, p. 2; emphasis added).

Applicant respectfully asserts the above Response is entirely incomprehensible. First, the Response states, “**comparing the measured power against the reflected data.**” Applicant does not claim a comparison of *power* against *data*. Furthermore, a comparison of dissimilar items, namely *power* against *data* is incomprehensible. Accordingly, the rejection is improper and must be withdrawn.

Second, Applicant respectfully asserts that Hulbert does not teach “summing” in the mobile station. The Response cites Hulbert at column 3, line 56 to col. 4, line 8 for supporting the Examiner’s position of Hulbert somehow teaching Applicant’s claim element of “*repeating [retransmitting] until a sum determined at the mobile station* of the *first and further* symbol energy *amounts* ... is great enough to” Applicant respectfully disagrees. In the citation to Hulbert, the only *association* of similar things is of “the data source ... before comparison against the reflected data.” (Hulbert, col. 4. lines 2-3). The citation in Hulbert continues by disclosing the nature of the *association* of “the data source” and “the reflected data” as being a “comparison.” Specifically, Hulbert discloses, “[t]he exclusive OR gate 300 performs the comparison.” (Hulbert, col. 4, lines 3-4). Applicant respectfully notes that a *comparison* by an “exclusive OR gate” is used to perform a Boolean operation and cannot disclose Applicant’s claim element of “*a sum determined at the mobile station* of the *first and further* symbol energy *amounts.*” Accordingly, the rejection is improper and must be withdrawn.

Applicant also respectfully asserts that the Office Action additionally alleges:

Hulbert discloses ... (C) repeating step (B) until *a sum determined at the mobile station* of the *first and further* symbol energy *amounts* used to transmit the traffic

information is great enough to permit correct demodulation by the mobile station (col. 3, lines 7-24, and col. 4, lines 1-10). (Office Action, pp. 3-4; emphasis added).

Applicant respectfully notes that the above citation to Hulbert at column 3, lines 7-24 and column 4, lines 1-10 also fails to disclose any "summing" and specifically not "a sum determined at the mobile station of the first and further symbol energy amounts" as claimed by Applicant. The Hulbert citation specifically discloses, "the bit which was transmitted is compared against the bit reflected back from the receiving station in order to identify ... [an] error ... [and] [w]hen an error is detected, the transmitted power is increased" (Hulbert, col. 3, lines 14-18). Hulbert further discloses, "[t]he exclusive OR gate 300 performs the comparison." (Hulbert, col. 4, lines 3-4). Again, Applicant respectfully notes that a *comparison* by an "exclusive OR gate" is used to perform a Boolean operation and cannot disclose Applicant's claim element of "a sum determined at the mobile station of the first and further symbol energy amounts."

Therefore, since Hulbert does not disclose in as complete detail as claimed by Applicant, Hulbert cannot anticipate under 35 U.S.C. §102 Applicant's invention as claimed in independent claim 1, from which claims 3-6, 8, 9 and 11 depend and independent claim 14. Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

35 U.S.C. § 103 Obviousness Rejections

Claims 7 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hulbert in view of U.S. Patent No. 6,581,176 to Seo ("Seo").

The nonobviousness of independent claim 1 precludes a rejection of claims 7 and 10 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to independent claim 1 and claims 7 and 10 which depend therefrom.

Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hulbert in view of U.S. Patent No. 6,625,132 to Boettger *et al.* (“Boettger”).

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of independent claims 12 and 13 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations. Regarding independent claims 12 and 13, Applicant’s independent claims 12 and 13 include claim limitations not taught or suggested in the cited references.

The Office Action cites Boettger for teaching a buffer. The Office Action cites Hulbert for teaching Applicant’s claim elements as described above. Applicant sustains the above-proffered arguments regarding the deficient teachings or suggestions in Hulbert. Accordingly, Applicant submits that Hulbert in view of Boettger does not and cannot render obvious under 35 U.S.C. § 103 the presently claimed invention of independent claims 12 and 13, because the cited references, either individually or in any proper combination, do not teach or suggest all of the claims limitations.

As stated above, Applicant’s invention as claimed generally recites:

(1) repeating a step until a sum determined at the mobile station of energy reaches a certain level.

Regarding a sum determined at the mobile station of energy, Applicant's invention as presently claimed in independent claims 12 and 13, recite in part, "transmits ... and retransmits ... until a sum determined at the mobile station of the first and further symbol *energy amounts ... is great enough to ...*" Neither Hulbert nor Boettger teach or suggest any such thing. In fact, Hulbert conflictingly teaches or suggests summing or accumulating occurring in the base station and not the mobile station as claimed by Applicant.

Specifically, Hulbert teaches that the "mobile station" (e.g., receiving station 22 of Hulbert's Fig. 2) merely includes sufficient intelligence for repeating (i.e., transmitting back) a received data stream. Furthermore, the Office Action cites Hulbert's transmitter 20 as teaching Applicant's base station claim element. (Office Action, p. 8). Furthermore, the only summing or accumulating capability as taught by Hulbert occurs in Hulbert's "base station" 20 and not in Hulbert's "mobile station" 22. In support, Applicant respectfully reiterates the above-proffered arguments with respect to the 35 U.S.C. § 102 rejections reciting the specific lack of teachings in Hulbert. Clearly, Hulbert teaches that any "summing" or accumulating only occurs in Hulbert's "base station" 20 and is not "a sum determined at the mobile station" as claimed by Applicant.

Therefore, since neither Hulbert nor Boettger, either individually or in any proper combination, teach or suggest Applicant's invention as presently claimed, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent claims 12 and 13.

Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

CONCLUSION

Claims 1 and 3-14 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned representative.

Respectfully submitted,

Dated:

1/21/2009

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